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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
via fax to (571) 273-8300		GE998-005	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>October 7, 2000</u>		Application Number <u>09/492,632</u>	Filed <u>01/27/2000</u>
Signature <u>Anne Vachon Dougherty</u>		First Named Inventor <u>E. M. Hamann, et al</u>	
Typed or printed name <u>Anne Vachon Dougherty</u>		Art Unit <u>2131</u>	Examiner <u>Syed Zia</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		Signature <u>Anne Vachon Dougherty</u>	
<input type="checkbox"/>	applicant/inventor.	Typed or printed name <u>Anne Vachon Dougherty</u>	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number <u>30,374</u>	Telephone number <u>(914) 962-5910</u>	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	Date <u>October 7, 2005</u>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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The Examiner has rejected Claims 1-15 under 35 USC 102 as anticipated by the Schaefer-Lorinser patent.

The present invention teaches and claims a signature device, such as a chipcard, which includes a signature program and additional signature certificate information for providing an expanded electronic signature to sign a document (page 6, lines 16-22). The signature device executes the signature program and does not require that an external authenticating entity generate the digital signature when the user is attempting to digitally sign a document ("the external and internal information together with the hash are merged on the chipcard 101", from page 13, line 14; "merger is effected by the chipcard program", from page 13, line 18; and, "[t]his encryption takes place on the chipcard", from page 14, lines 11-12). ***The digital signature includes an identifier of the signature device as well as at least one identifying characteristic indicating the hardware and software environment used in generating the electronic signature*** (see: page 3, lines 1-3; page 4, lines 1-4; page 13, lines 4-7; and page 15, lines 6-9) as well as a document extract value identifying the document which is being signed (see: page 12, lines 19-20; and page 14, lines 23-24). All of the independent claims, Claims 1, 9, 11, and 12 as amended, expressly recite that the signature device stores the signature program which is to be executed as well the necessary additional information so that it

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can perform digital signing of a document, and that the digital signing incorporates ***an identifier of the signature device***, as well as ***at least one characteristic*** indicating the hardware and software environment used in generating the signature, and ***a document extract value for the document to be signed***.

The Schaefer-Lorinser patent is directed to a system for secured reading and processing of data on intelligent data carriers, even when the terminal which is reading and processing the data is not connected to a server for authentication of the data carrier. Under the Schaefer-Lorinser system and method, the data carrier (i.e., the chipcard) and the terminal exchange cryptograms for authentication of the data carrier. Data used for generating a cryptogram at the data carrier is encoded at the data carrier when it is first issued (see: Col. 3, lines 51-55). Similarly, data used for generating cryptograms at the terminal is permanently stored at the terminal (see: Col. 4, lines 6-8), so that connection to a server is not required for authentication. As taught by Schaefer-Lorinser at Col. 3, lines 52-56, the data carrier/chipcard has a certificate "representing an electronic signature". When the data carrier generates a so-called "acknowledgment cryptogram" (Col. 4, lines 61-64) that is the electronic signature, e3, (see, Fig. 2) the data carrier applies a signature function Scard (defined at Col. 3, lines 65) on a data set comprising the ID number of the data carrier, a posting data record, DB, (see: Col. 4, lines 54-55) and a random

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number, R3, which has been generated by the terminal (se: Col. 4, lines 47-48).

The present invention first creates a signature data set which comprises the received input information, an identifier to identify the signature device, at least one identifying characteristic of the hardware and software environment used for generating said digital signature, and a document extract value. The Schaefer-Lorinser patent does not teach or suggest a step of creating a signature data set, let alone one which includes the recited data. Schaefer-Lorinser does not teach or suggest the existence or use of an identifying characteristic of the hardware and software environment used for generating the digital signature. Such is clearly taught by the present Specification, for example on page 13, lines 1-12, to include, in addition to an identifier, a signature counter value, an indication of the encryption method used, or an identifier of the program such as a license number or program serial number, and is now expressly claimed. The Examiner has stated, at the bottom of page 4 of the Office Action, that Schaefer-Lorinser includes a device identification number, which the Examiner analogizes to the claimed "at least one characteristic". However, the claims expressly recite that the signature data set includes **both** an identifier to identify the signature device **and** at least one identifying characteristic. Clearly, Schaefer-Lorinser does not provide both.

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Furthermore, the Schaefer-Lorinser use of a "posting data record" is not the same as or suggestive of a document extract value of a document for signing, as is taught and claimed for the present invention. Schaefer-Lorinser's posting data record records the currency and amount of the debit and the posting number and time. Such information is not a document extract value.

It is well established under U. S. Patent Law that, for a reference to anticipate claim language under 35 USC 102, that reference must teach each and every claim feature. Since the Schaefer-Lorinser patent does not teach the signature device and method as claimed, including means and steps for a signature device, having a signature program and certificate, to generate a digital signature which identifies the signature device and at least one characteristic of the environment used to generate the signature, and a document extract value for the document to be signed, it cannot be maintained that the Schaefer-Lorinser patent anticipates the invention as set forth in the independent claims, Claims 1, 9 and 11, and in all of the claims which depend therefrom. Accordingly, Applicants believe that the Examiner erred in rejecting the claims as anticipated by Schaefer-Lorinser.